

REMARKS

Claims 1-45 are pending in the application.

Claims 1-45 have been rejected.

Reconsideration of the Claims is respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

Claims 1-2, 6, 8-13, 17, 19, 20-36, 38-39 and 41-45 were rejected under 35 U.S.C. § 102(e) as being anticipated by Goedken (US 6,393,423). The rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

With respect to independent Claims 1, 34 and 41, the Office Action bases the anticipation rejection on the following passage from Goedken:

Many well known chat rooms and other "instant" messaging systems have many of the features of both direct and grouped messaging systems. Participants may enter "rooms" designated by topic (i.e., the address of the room). Subsequently, any and all participants may type messages which are then displayed on all other participant's screens. Similarly, participants may designate topics they are interested in by completing a personal profile. Then, other participants may contact similarly interested participants by searching a directory

of potential participants. Participants wishing to engage in one-to-one conversations may enter private rooms and/or exchange e-mail addresses.

Col. 2-3, lines 58-2.

Goedken's directory of potential participants (similarly interested persons) are not associated with a particular individual. Instead, Goedken's directory of similarly interested persons is generated by selecting participants for the directory based upon the participant designating topics (the participant is interested in) in a personal profile completed by each participant. In such cases, the participant directory is simply a list of participants who have identified certain topics in which they are interested (obtained from the completion of a personal profile). In contrast, and with respect to independent Claim 1, Applicant's invention retrieves information about one or more additional individuals from memory associated with a second individual. Applicant's specification discloses:

... Each user in the system 100 has a personal directory 20 containing the names of other people with collaborative conferencing capability.

Unlike conventional methods of matchmaking in a chat room context, user A does not rely on a computer program to pick interesting person for him or her. Instead, user A relies on user B's personal directory 20 as a starting point to find more interesting persons. User A accesses some of the information contained in directory 20 about others users with collaborative conferencing capability, with whom user B communicates. This technique is called recursive identification of individuals. The information that user A can access is limited according to permissions assigned to each record in the directory by user B . . .

Specification, page 9, lines 1-11. Therefore, Goedken does not disclose retrieving information about one or more individuals from electronic memory means associated with the second individual, as recited in independent Claim 1 (and dependent Claims 2-33).

With respect to independent Claims 34 and 41, the Office Action cites the same passage in Goedken, as shown above, for the anticipation rejection. However, Goedken does not disclose a display for displaying in real-time a representation of persons only those persons in the virtual space room who have been defined as likely to be interesting (as recited in Applicant's Claim 34), or a display for displaying in real-time a representation of person from the virtual space room (as recited in Applicant's Claim 41).

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(e) rejection of Claims 1-2, 6, 8-13, 17, 19, 20-36, 38-39 and 41-45.

II. REJECTIONS UNDER 35 U.S.C. § 103

Claims 7 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goedken (US 6,393,423). Claims 3, 4, 5, 14, 15, 16, 37 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goedken (US 6,393,423), and further in view of Leipow (US 6,148,067). Claims 5, 16 and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goedken (US 6,393,423), Leipow (US 6,148,067), and further in view of Herz (US 6,029,195). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP §

2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

For the same reasons as stated above, Goedken does not disclose, teach or suggest those features of Applicant's independent Claims 1, 34, and 41, as noted above. Therefore, the Office Action has failed to establish a prima facie case of obviousness with respect to dependent Claims 3, 4, 5, 7, 14, 15, 16, 18, 37 and 40.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejections of Claims 3, 4, 5, 7, 14, 15, 16, 18, 37 and 40.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

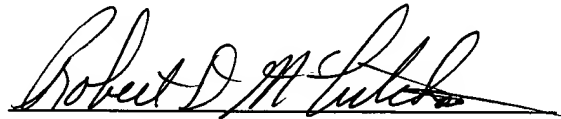
If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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Date: 12/6/2002



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